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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A7483

Xiao-Mai ZHOU

Appln. No.: 09/580,523

Group Art Unit: 1642

Confirmation No.: 8284

Examiner: Minh Tam Davis

Filed: May 30, 2000

For: COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS OF MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705

MAIL STOP PATENT EXT.

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants request reconsideration of the Director's determination of patent term adjustment (PTA) as communicated in the Notice of Allowance mailed on December 7, 2004. In particular, Applicant requests restoration of 355 days of PTA erroneously charged against Applicant under 37 C.F.R. § 1.704(b) and an addition of 314 days to the USPTO delay under 37 C.F.R. § 1.702(a)(2).

This application is filed concurrently with the payment of the Issue Fee and is therefore timely. The Director is authorized to charge Applicant's Deposit Account No. 19-4880 for the required fee as specified in §1.18(e) (\$200.00).

11/13/2006 MAHMED2 00000147 194880 09580523
01 FC:1455 200.00 DA

Facts

1. Attached is a printout of the Office's determination of PTA for this application, as provided on PAIR. The net PTA shown on the printout is 0 (zero) days.

2. (§ 1.705)(2)(i). For the following reasons, the correct PTA to which this application is entitled is 120 days.

3. (§ 1.705)(2)(ii). The examination delays under § 1.702(a) and § 1.703, are the following:

(a) 30 days for failing to mail the Restriction Requirement within 14 months of filing, for the interval between May 30, 2000 and August 29, 2001 (correctly shown on the PAIR printout).

(b) 314 days for the interval from May 2, 2003 to July 12, 2004 for failing to respond to Applicant's Response to Non-Final Action filed May 2, 2003 within four months (not shown on the PAIR printout).

The sum of these delays is 345 days (§ 1.703)(f).

4. (§ 1.705)(2)(iii). This application is not subject to a terminal disclaimer.

5. (§ 1.705)(2)(iv)(A). The reductions under § 1.704 as shown on the attached PAIR printout which Applicant believes to be correct are the following:

(a) 2 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between December 19, 2001 and March 21, 2002.

- (b) 29 days for failing to file a Response to a Final Office Action within three months, for the interval between June 19, 2002 and October 18, 2002.
- (c) 31 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between July 12, 2004 and November 12, 2004.
- (d) 58 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between February 10, 2005 and July 7, 2005.
- (e) 92 days for failing to file a Response to a Final Office Action within three months, for the interval between December 29, 2005 and June 29, 2006.

6. The PAIR entry for a Response after Non-Final Action on April 19, 2004 does not correspond to a failure by the Applicant to engage in reasonable efforts to conclude prosecution.

(a) On January 13, 2003, a Non-Final Rejection was mailed. Applicant responded by filing a Response after Non-Final Action on April 17, 2003. The USPTO determined that Applicant's response was Informal and on April 24, 2003, mailed a Notice of Informal or Non-responsive Amendment, which set a one-month period for response. As is evident from the USPTO date-stamped Filing Receipt submitted herewith, on May 2, 2003, Applicant timely responded to the Notice of Informal or Non-responsive Amendment. Applicant did so by filing a Revised Amendment Under 37 C.F.R. § 1.111 and a Petition and check for a one-month extension of time to respond to the Non-Final Rejection mailed January 13, 2003.

(b) On November 4, 2003 and again on April 19, 2004, Applicant's agent contacted the Examiner by phone to ask the status of the application. Both times, the Examiner advised that Applicant's Response filed May 2, 2003 was not of record. Also,

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both times, at the Examiner's request, Applicant faxed a copy of the Response previously filed on May 2, 2003 to the Examiner (copies of the fax cover sheet are attached herewith).

(c) The papers faxed on November 4, 2003 and April 19, 2004 were identical to the response filed on May 2, 2003. However, these papers were erroneously entered into the PALM database as filed on April 19, 2004 rather than on May 2, 2003.

(d) As Applicant's Response to the Non-Final Rejection mailed January 13, 2003 was due April 15, 2003 (April 13th and 14th were a Saturday and Sunday), Applicant's delay was 13 days.

The sum of Applicant's delay is 225 days ($2+29+13+31+58+92 = 225$).

Discussion

Applicant believes that the act of filing a duplicate copy of a paper previously submitted to comply with an Examiner's request does not constitute a failure to engage in reasonable efforts to conclude prosecution. In this instance, the Response in question was first properly filed on a date which, under PTO rules and practice, resulted in only a 13 day delay. Accordingly, the submission of the papers filed on April 19, 2004 should not result in a reduction of 368 days under § 1.704.

The duplicate Response was not a submission to rectify an omission in an earlier filing (§1.704(c)(7)) or a supplemental reply (§1.704(c)(8)). Instead, it contained only copies of papers already filed with the Office, provided for the Examiner's convenience and at the Examiner's request.

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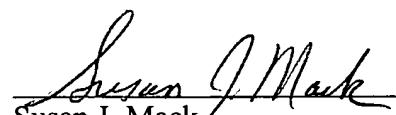
The proper treatment of the submission is indicated in the discussion of §1.704(c)(8) at M.P.E.P. §2732, which states that “[§] 1.704(c)(8) does not apply to a supplemental reply or other paper that was expressly requested by the examiner.” For an expressly requested amendment, for example, “the examiner will have the paper processed so that it is included as part of an interview summary or examiner’s amendment and not a separate paper for PALM to flag in the patent term adjustment calculation.” M.P.E.P. 8th ed, Rev. 2, at 2700-20, paragraph bridging columns.

The same procedure should have been followed with the papers submitted on April 19, 2004. Because the papers were expressly requested by the Examiner, and because they did not constitute any new action corresponding to a failure to engage in reasonable efforts to conclude prosecution, the PALM entry indicating that the submission was a new Response was in error.

Conclusion

Applicant respectfully requests correction of the Office’s records and adjustment of the Office’s calculation of term adjustment by the addition of 120 days of patent term adjustment (345 days of USPTO delay - 225 days of Applicant delay).

Respectfully submitted,



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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 7, 2006



Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 09/580,523

Filing or 371(c) Date:	05-30-2000	USPTO Delay (PTO) Delay (days):	30
Issue Date of Patent:	null	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	580
Post-Issue Petitions (days):	+0	Total PTA (days):	0
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
08-11-2006	Mail Notice of Allowance		
08-11-2006	Mail Examiner's Amendment		
07-24-2006	Notice of Allowance Data Verification Completed		
07-24-2006	Examiner's Amendment Communication		
07-08-2006	Date Forwarded to Examiner		
07-08-2006	Date Forwarded to Examiner		
06-29-2006	Request for Continued Examination (RCE)	92	
07-08-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
06-29-2006	Request for Extension of Time- Granted		↑
06-29-2006	Workflow - Request for RCE - Begin		↑
06-02-2006	Date Forwarded to Examiner		↑
05-26-2006	Amendment after Final Rejection		↑
05-26-2006	Request for Extension of Time - Granted		↑
05-26-2006	Miscellaneous Incoming Letter		↑
05-15-2006	Mail Examiner Interview Summary (PTOL - 413)		↑
04-27-2006	Examiner Interview Summary Record (PTOL - 413)		↑
12-29-2005	Mail Final Rejection (PTOL - 326)		↑
12-23-2005	Final Rejection		
11-30-2005	IFW TSS Processing by Tech Center Complete		
11-30-2005	Date Forwarded to Examiner		
11-22-2005	Response after Non-Final Action		
08-25-2005	Mail Non-Final Rejection		
08-22-2005	Non-Final Rejection		
07-15-2005	Date Forwarded to Examiner		
07-07-2005	Response after Non-Final Action	58	
07-07-2005	Request for Extension of Time - Granted		↑
05-03-2005	Information Disclosure Statement (IDS) Filed		↑
02-10-2005	Mail Non-Final Rejection		↑
02-07-2005	Non-Final Rejection		↑
11-27-2004	Date Forwarded to Examiner		
11-12-2004	Response after Non-Final Action		31
11-12-2004	Request for Extension of Time - Granted		↑

11-12-2004	Workflow incoming amendment IFW	↑
07-12-2004	Mail Non-Final Rejection	↑
07-09-2004	Non-Final Rejection	↑
05-12-2004	Date Forwarded to Examiner	↑
04-19-2004	Response after Non-Final Action	368
04-29-2004	Request for Extension of Time - Granted	↑
05-30-2003	Information Disclosure Statement (IDS) Filed	↑
04-24-2003	Mail Notice of Informal or Non-Responsive Amendment	↑
04-24-2003	Date Forwarded to Examiner	↑
04-17-2003	Informal or Non-Responsive Amendment after Examiner Action	↑
04-17-2003	Response after Non-Final Action	↑
01-17-2003	Mail Non-Final Rejection	↑
01-13-2003	Non-Final Rejection	↑
12-19-2002	Notice of Appeal Filed	↑
12-19-2002	Request for Extension of Time - Granted	↑
10-24-2002	Date Forwarded to Examiner	↑
10-18-2002	Amendment after Final Rejection	29
10-18-2002	Request for Extension of Time - Granted	↑
06-19-2002	Mail Final Rejection (PTOL - 326)	↑
06-17-2002	Final Rejection	↑
04-17-2002	Date Forwarded to Examiner	368
03-21-2002	Response after Non-Final Action	2
03-21-2002	Request for Extension of Time - Granted	↑
12-19-2001	Mail Non-Final Rejection	↑
12-17-2001	Non-Final Rejection	↑
10-04-2001	Date Forwarded to Examiner	↑
09-26-2001	Response to Election / Restriction Filed	↑
08-29-2001	Mail Restriction Requirement	30
08-27-2001	Requirement for Restriction / Election	↑
02-13-2001	Case Docketed to Examiner in GAU	↑
02-01-2001	Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27	↑
10-17-2000	Information Disclosure Statement (IDS) Filed	↑
09-12-2000	Case Docketed to Examiner in GAU	↑
08-31-2000	CRF Is Good Technically / Entered into Database	↑
08-17-2000	Application Dispatched from OIPE	↑
08-17-2000	Application Is Now Complete	↑
07-31-2000	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
07-31-2000	Correspondence Address Change	↑
06-20-2000	IFW Scan & PACR Auto Security Review	↑
05-30-2000	CRF Is Good Technically / Entered into Database	↑
05-30-2000	Initial Exam Team nn	↑

APR-19-2004 16:25

SUGHRUE MION

202 293 7860 P.02



FILING RECEIPT
PLEASE DATE STAMP AND RETURN TO US - BOX 235X

In re application of

Xiao-Mai ZHOU

Appn. No.: 09/580,523

Confirmation No.: 8284

Filed: May 30, 2000



Group Art Unit: 1642

Examiner: Davis, M.

For: COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS OF
MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS

PAPER(S) FILED ENTITLED:

1. REVISED AMENDMENT UNDER 37 C.F.R. §1.111
2. PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136
in duplicate with Check No. 221476 in the amount of \$55.00

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DOCKET NO.: A7483

ATTORNEY/SEC: SJM/DXH

Date Filed: May 2, 2003

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

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FAX

Date November 4, 2003 Apr. 19, 2004
To Examiner M. Davis
Of U.S. PTO
Fax 703-746-7145 571 - 273 - 0830
From Drew Hissong
Our Ref A7483 Your Ref 09/580,523
Pages 30
(including cover sheet)

Please call attention to problems with this transmission by return fax or telephone. Thank you.

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Dear Examiner Davis:

As we discussed, I am enclosing a copy of the Revised Amendment, Petition for Extension of Time and date-stamped filing receipt. As I mentioned, the Revised Amendment and Petition were filed in the U.S. PTO on May 2, 2003, as evidenced by the date-stamped filing receipt.

Please let me know if I can provide any further information or assistance.

Very truly yours,

Drew Hissong
202-857-2245 (direct line)